

REMARKS

The Examiner has objected claims 3-6 under 37 C.F.R. § 1.75(c) as allegedly being in improper form for being multiple dependent claims which do not refer to more than one claim in the alternative. Accordingly, the Applicants have amended claim 3 to refer to more than one claim now using the alternative language "or". Claims 4, 5, and 6 are now properly dependent upon claim 3 which, in its amended form, is a proper multiple dependent claim. Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of claims 3-6 on these grounds.

The Examiner has rejected claim 1 under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out the invention due to the use of the phrase "if desired" for various process steps which are meant to be referred to as optional steps. The Applicants have amended the language of claim 1 so that all instances of the use of "if desired" have been replaced with the word "optionally". The deleted language, "if desired", is used in the original United Kingdom and European claims in the priority application. The use of the word "optionally" reflects the original intent of the Applicants in more proper United States practice language. The Applicants therefore respectfully request that the Examiner withdraw the rejections upon these grounds.

The Examiner has also rejected claim 1 under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out the invention due to the use of the phrase "compound of the invention". The Applicants have amended claim 1 to delete such language and replace it with "compound of formula I". In this way, the Applicants seek to highlight the compounds corresponding to formula I which result from the process described in claim 1 and reflected in the language on page 1 in lines 1-14 of the Specification. The Applicants therefore respectfully request that the Examiner withdraw the rejections upon these grounds.

The Examiner has rejected claim 2 as allegedly being drawn to an improper Markush grouping of processes. Claim 2 claims alternative methods of preparation of 2-aryl-amino-arylacetic acids (COX-2 Inhibitors). An overview of synthetic methodologies of the processes claimed in claim 2 is included in the Specification on page 11. As such, the processes steps claimed in claim 2 are well described and identified as producing intermediates in the production of the compound of formula I which has specific COX-2 inhibitory activity. The Applicants assert that the synthetic methodology flowchart on page 11 of the Specification establishes the requisite unity and is

reflected in the process steps claimed in claim 2. Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of claim 2 upon these grounds.

The Examiner has rejected claim 7 as allegedly being drawn to an improper Markush grouping of compounds. The Examiner states that the members of the Markush group do not belong to a recognized class or that they do not possess common use or have separate uses in distinct processes. The Applicants assert that claim 7 claims compounds which may be used in the synthesis of 2-aryl-amino-arylacetic acids (COX-2 Inhibitors) that are exemplified in a compound of formula I as claimed in claim 1. The Overview of synthetic methodologies on page 11 of the Specification establishes that the compounds claimed in claim 7 are compounds which either a) have COX-2 inhibitory activity individually and/or b) are compounds which may be used as intermediates in synthetic methodologies which ultimately lead to a production of a compound of formula I as shown on page 11 of the Specification. The Applicants assert that the synthetic methodology flowchart on page 11 of the Specification exemplifies the required commonality for the Markush grouping which of claim 7. Therefore, the Applicants respectfully disagree with the Examiner's rejections and characterization of the compounds of claim 7 and request that the Examiner withdraw the rejection of claim 7 on these grounds.

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 103(a) over WO 99/11605 and U.S. Patent No. 3,558,690. The Examiner states that the Applicants' claimed process affords the products of the teachings of the prior art and that the use of a new starting material in an otherwise old process is considered obvious. The Examiner further states that the Applicants' products are "admittedly well known useful products" and cites Example 38 of WO 99/11605 and compounds of formula III (a) of US Patent No. 3,558,690 in order to attempt to make this point. The Applicants respectfully disagree with the Examiner and request that the rejection be withdrawn. Formula I as disclosed and claimed in the present Application provides that R1, R2, R4 and R5 are not all fluoro when R is ethyl and R3 is hydrogen (please see claim 1, page 46, line 12 and page 1 line 14 of the Specification). Therefore, a compound of formula I as disclosed and claimed in the present Application specifically excludes the starting compounds and the products of Example 38 and the claims of WO 99/11605 and also excludes the compounds of formula III (a) as disclosed in US Patent No. 3,558,690. The Applicant disagrees that one would be motivated by the prior art teachings to make the compounds of the present invention via the process claimed in claims 1 and 2. In opposition to the Examiner's statements that the products are well-known in the art, the specific utility of the compounds as either COX-2 inhibitors or intermediates in the synthesis of such compounds is new and not disclosed in the prior art. There is no suggestion that one could make the COX-2 inhibitors of the present invention via the processes claimed in the present application. The exclusion of compounds in Example 38 of

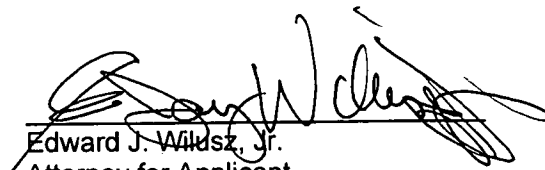
WO 99/11605 and US 3,558,690 exemplifies the fact that such compounds are newly identified and claimed in the present Application. The Applicants therefore respectfully request that the Examiner withdraw the rejection of claims 1 and 2 on these grounds.

The Examiner has rejected claim 7 under 35 U.S.C. § 103(a) over WO 99/11605 and U.S. Patent No. 3,558,690. The Examiner states that the compounds of the present invention as claimed in claim 7 are homologues of the class of compounds of the references. The Applicants respectfully disagree with the Examiner and request that the rejection be withdrawn. As discussed above, for the rejection of claim 1 and 2, the prior art references do not disclose and claim that the specific starting materials or products may be used as intermediates in the preparation of the COX-2 inhibitors of the present invention. This includes the compounds of claim 7. The Applicants dispute that the compounds of claim 7 are homologues of the prior art disclosures. The community of properties associating the compounds of claim 7 in the present Application identifies that they are synthetic precursors to COX-2 inhibitors claimed in formula I. The compounds of formula I differ by more than a methylene linkage over the prior art cited by the Examiner. The compounds of the invention differ in the identities of from two to five substituents over the prior art as shown in claim 1 on page 46 in line 12. The compounds of claim 7 differ over the prior art by having different groups on both of the phenyl rings of the compounds of the invention. The Applicants assert that the compounds of the present invention are not taught by the prior art for the use claimed by the Applicants. The compounds claimed in the present application are in fact specifically selected outside of the prior art because they have been determined by the Applicants to be useful for preparation of the COX-2 inhibitor reaction products claimed in the present application. The Applicants therefore respectfully request that the Examiner withdraw the rejection of claims 1 and 2 on these grounds.

In light of the foregoing amendment and remarks the Applicants believe the Application is in condition for allowance and respectfully request early notice to that effect. If it will advance prosecution of the Application the Examiner is urged to contact the Applicants' undersigned counsel at the telephone number listed below.

Respectfully submitted,

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